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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/713,603	11/15/2000	Adam Coyle		5258

20350 7590 04/05/2004

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EXAMINER

PATEL, JAGDISH

ART UNIT PAPER NUMBER

3624

DATE MAILED: 04/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/713,603

Applicant(s)

COYLE, ADAM

Examiner

JAGDISH PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-12,14-19 and 21-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1,3,5-12,14-19 and 21-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. In view of the appeal brief filed on 11/13/03, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

2. If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Status of Pending Claims:

3. Claims 1,3,5-12,14-19 and 21-23 are pending and have been examined. The pending claims have been rejected on the grounds not necessitated by the pervious amendments. Accordingly, this office action is a non-final office action.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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Claims 1,3,5-9 are rejected under 35 USC § 101 the claimed inventions lack patentable utility. Note that recitation "said card being usable for:" is not afforded any patentable weight because the process steps that the card is usable for are not supported by the structure of the system. In this regard, the recitation that "said card is usable for" certain processes (interpreted to read capable of performing the listed functional steps) is considered as intended use of the card as recited in the "structural" limitation of the system (a card, a card identifier, a reloadable value and a subaccount). Therefore, the claimed stored-value card system having the aforementioned elements lack any patentable utility and are accordingly rejected under 35 USC § 101 as non-statutory. The examiner suggests amending the claim in a manner that the process or functions of the card are recited as being performed by one or more elements of the card system.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1,3,5-12,14-19 and 21-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to

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particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 1 is indefinite because the individual elements of the claimed system in combination do not achieve any functionality. Although the claim recites that the card is "usable" for making purchase and redeeming a balance of the subaccount, the claimed system has no elements that would collectively accomplish these steps. Note that this deficiency is inherited by dependent claims 3 and 5-9.

8. Regarding claims 3 and 5 limitations "said negotiable instrument" and "said card values" are not recited in the parent claim 1 as being the limitations of the claimed system.

9. Regarding claim 9 there is insufficient antecedent basis for the limitation "said reader" in line 1. this limitation in the claim. Examiner has interpreted claim 9 to depend upon claim 8 for proper antecedent support.

10. Regarding claim 16 there is insufficient antecedent basis for the limitation "the numerical identifier". For proper antecedent basis claim 16 is interpreted as dependent upon claim 15.

11. Claims 10-23 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP

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§ 2172.01. The omitted steps are (refer to claim 10):

functional relationship of limitation "issuing an instruction to generate a negotiable instrument .." to the preceding functional limitations. Note that the issuing step is performed regardless of at least the "crediting" and "debiting" steps of the claim, i.e. the issuing step can be performed independent of the aforementioned steps.

12. dependent claims 11-12, 14-19 and 21-23 also inherit same defect as parent claim 10.

13. claims 12,14,19 and 21 are indefinite because the claims do not positively further limit any process or act of the parent claim.

As an example claim 12 recite further limitation of "said initial reloadable values". However, it is noted that the claimed method would perform in same manner regardless of any attribute of the initial reloadable values. The debiting step is not dependent upon the crediting step in terms of a specific attribute of the initial reloadable values associated with the sub-accounts.

14. claims 17-18 and 22-23 recite limitations pertaining to a transaction authorization. These limitations do not positively relate to steps of "crediting" , "debiting" and "issuing an instruction" of parent claim 10. Is the transaction of claim 17

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related to the purchase made? How the limitation sufficient funds are determined in terms of the aforementioned steps of claim 10.

Claim Rejections - 35 USC § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

16. Claims 1,3,7-12,14, 15, 17-19 and 21-23 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Weiss (US Pat. 6,511,377) (Hereafter Weiss).

Claim 1: Weiss discloses a stored-value card system, which comprises:

a card issued by a card issuing institution;

(col. 2 L 62-64, player cards)

a card identifier associated with said card and assigned thereto by the issuing institution;

(col. 2 L 62-64 player selected or randomly assigned personal identification number)

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a reloadable value associated with said card and credited to the card by the issuing institution; and

(col. 5 L 1-5, "depositing funds into their account", noting that the account is associated with the card)

a sub-account associated with said card and identified by the card identifier,

(col. 3 L 11+, ..system which allows players to establish an electronic account as easily as selecting a personal identification number and depositing funds at an enrollment station. Deposits can be comprised of cash, chips, checks or marker proceeds. After the account has been established, the player receives a player card which may be used at any gaming machine. The electronic account is accessed at any particular gaming machine via the player card and the associated personal identification number.)

said card being usable for:

making a purchase by presenting said card at a point-of-sale establishment and debiting a cost of the purchase from the said sub-account; and
redeeming a balance of the sub-account in the form of a negotiable instrument payable to a holder of the sub-account. (although not functionally related to the claimed system elements as discussed previously, this features are also explicitly disclosed in Weiss patent. For example, refer to col. 3 L 11+ he electronic account is accessed at any particular gaming machine via the player card and the associated personal identification number. The player accesses funds from the electronic account by simply inserting the player tracking card into a card reader, entering the personal identification number associated with the card ..)

Claim 3. wherein said negotiable instrument comprises a money order (col. 3 L 57+ redemption apparatus).

Claim 7. wherein said card includes a magnetic strip, the card identifier being encoded on the magnetic strip.

(col. 8 L 54+ refer to fields identified as 1-9, filed 5 refers to card identification where one method of identification is card insertion, i.e. the identification is read via insertion of the card in the card reader, referring to col. 21 L 18+ read-write machine interface 82 shown in Fig. 10 shows a magnetic strip used to read the card identification)

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Claim 8. wherein said card identifier is adapted to be read by a reader at the point-of-sale retail establishment.

(refer to analysis of claim 7 noting that the POS is the location wagering where the customer uses the card for services)

Claim 9. wherein said reader is in communication with a network comprising multiple point-of-sale establishments which accept said card for the purchase of goods and services.

(refer to Figure 1 refers to $G_1, G_2..G_N$).

Claim 10. Weiss discloses a method of purchasing goods and services in transactions utilizing value-added cards, which method comprises the steps of

issuing a plurality of said cards to a point-of-sale retail establishment;

(col. 2 L 62-64, col. 3 L 11+ player cards)

pre-assigning sub-account identifiers to said cards;

(col. 3 L 11+ player cards and account has been established..player receives a player card)

crediting the sub-accounts associated with said cards with initial reloadable values;

(col. 3 L 11+ player cards and account has been established..player receives a player card)

debiting a respective sub-account in response to a purchase made with a respective one of said cards at a merchant; and

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(col. 7 L 25-46, refer to download funds from the account to the gaming machine, in this context download amounts to debiting the sub-account ("account"))

issuing an instruction to generate a negotiable instrument payable of a balance of the respective sub-account to a holder of the respective sub-account in response to a request to redeem the respective one of the cards by said holder.

(Col. 7 L 51-58 refer to redeem the balance for vouchers)

Claim 11. The method of claim 10, which includes the additional step of reloading said respective one of the cards in response to a purchase of additional values by said holder, by crediting said respective sub-account.

(refer to Fig. 7 ..deposit funds to his electronic account)

Claim 12. wherein said initial reloadable values correspond to predetermined amounts.

(col. 11 L 40-42, cash denominations)

Claim 14. wherein the negotiable instrument comprises a money order.

(col. 3 L 57+ redemption apparatus).

Claim 15. wherein the respective one of said cards includes a numerical identifier corresponding to said respective sub-account.

(col. 3 L 18+ personal identification number associated with the card)

Claim 17. receiving a transaction authorization request, including an amount of a transaction and the sub-account identifier corresponding to the respective sub-account; and authorizing the transaction if sufficient funds are available in the respective sub account.

(refer to fig. 1, and relevant discussion on col. 7)

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Claim 18. wherein the transaction authorization request was generated by a first computational device at the merchant and received by a second computational device linked to the first computational device.

(first device is a gaming device G1,..GN at the casino and second computational device is Bank/Progressive controller 94 shown in Fig.1)

Claim 19. wherein the respective one of said cards includes a magnetic strip for encoding the sub-account identifier for the respective sub-account.

(col. 8 L 54+ refer to fields identified as 1-9, filed 5 refers to card identification where one method of identification is card insertion, i.e. the identification is read via insertion of the card in the card reader, referring to col. 21 L 18+ read-write machine interface 82 shown in Fig. 10 shows a magnetic strip used to read the card identification)

Claim 21. wherein said additional values correspond to predetermined incremental amounts.

(col. 11 L 40-42, cash denominations)

Claim 22. (Previously Presented) The method of claim 19, which includes the additional steps of:
receiving a transaction authorization request, including an amount of a transaction and the sub-account identifier; and
authorizing the transaction if sufficient funds are available
in the respective subaccount.

(refer to fig. 1, and relevant discussion on col. 7)

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Claim 23. wherein the transaction authorization request was generated by a first computational device adapted to read the sub account identifier from the magnetic strip, and received by a second computational device.

(transaction authorization request is generated by gaming machine GN which reads the sub account identifier from the magnetic strip (refer to discussion of prior claims) and received by a Bank/Progressive controller, 94 shown in Figure 1).

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 5, 6 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss.

14. Per claims 5 and 6, Weiss does not disclose that card values are not redeemable for cash and that the card identifier is printed on the card and selectively concealed by a removable strip attached to the card.

Over the years, numerous court decisions have analyzed the content of various claim language for meaningful, useful differences in structure or acts performed between the claims and the prior art. Some of these decisions have

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found that certain language adds little, if anything, to the claimed structure or acts and thus do not serve as a limitation on the claims to distinguish over the prior art. For example, *language directed to an intended use of dispensing popcorn in a claim for a product did not result in a structural or functional difference with respect to prior art and were held not to serve as a limitation on the claim.* See *In re Schreiber*, 44 USPQ2d 1429 (CAFC 1997).

Thus, a limitation on a claim can broadly be thought of then as its ability *to make a meaningful contribution to the definition of the invention in a claim.* In other words, *language that is not functionally interrelated with the useful acts, structure, or properties of the claimed invention will not serve as a limitation.* See *In re Gulack*, 217 USPQ 401 (CAFC 1983), *Ex parte Carver*, 227 USPQ 465 (BdPatApp&Int 1985) and *in re Lowry*, 32 USPQ2d 1031 (CAFC 1994) where language provided certain limitations because of specific relationships required by the claims.

In the instant case the limitations of card values and the card identifier as per claims 5 and 6 do not make any contribution to the functionality of the stored-value card system of claim 1.

15. Therefore, it would have been obvious to a person of ordinary skill of art at the time of the invention was made to have the card values not redeemable for cash and the card identifier printed on the card and selectively concealed by a removable strip attached to the card because such data does not functionally relate to the functionality of the system claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Claim 16 is also similarly analyzed as claims 5 and 6.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jagdish Patel whose telephone number is (703) 308-7837. The examiner can normally be reached Monday-Thursday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1038. The fax number for Formal or Official faxes to Technology Center 3600 is (703) 305-7687. **Draft faxes may be submitted directly to the examiner at (703) 746-5563.**

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 308-1114. Address for hand delivery is 2451 Crystal Drive, Crystal Park 5, 7th Floor, Alexandria VA 22202.



Jagdish Patel

(Primary Examiner, AU 3624)

3/30/04